

## REMARKS

Claim 1-18 are pending in the present application. Claims 1-6, 8, 9, 16 and 17 are under examination, with claims 7 and 10-15 being withdrawn as being directed to a non-elected invention. New claims 16-18 have been added.

The Office Action rejects claims 1-6, 8 and 9 under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,501,560 to Blume ("Blume"). Applicants respectfully traverse this rejection.

The present claims are directed to a web. As disclosed in Applicants' specification and Figures, the web is continuous. (See, for example, page 38, line 25, describing a "running web 10"; Fig 6). Furthermore, the term "web" is often used to define a continuous roll of paper for use in a rotary press. For the Examiner's convenience, attached is page 1513 of Webster's New World Dictionary (1986) including the definition. The Blume apparatus employs the use of a conveyor to advance sheets of paper. Clearly, the individual paper sheets of Blume are not the continuous web of the claimed invention. The language of Blume cannot be construed to cover the web of Applicants' invention, nor would it be possible to adapt the apparatus of Blume to for use with the web of the present claims. Thus, Blume does not render obvious the present claims.

The Office Action states that the "intended use articulation found in the preamble of the claims is not deemed to patentably distinguish the claims from the [Blume] reference" (Office Action, page 3). It is established caselaw that limitations in the preamble of a claim must be considered in a patentability determination when the limitations of the preamble give meaning to the claim and properly define the invention. (See *Perkin Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984). Language in a preamble is a limitation when the preamble gives "life and meaning" to the manipulative

steps. See *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ 2d 1816, 1820 (Fed. Cir. 1995).

Clearly, the preamble of claim 1 gives such life and meaning to the recited steps. Though the preamble of claim 1 does state the intended use, the preamble also gives meaning to the claim and defines the invention. Present claim 1 has no context and no meaning without the preamble. Thus, the Examiner cannot overlook the fact that the Blume apparatus is for use with mailable documents, where the present invention is for use with wrapping material for smokers' products. For this reason, the Blume reference does not render obvious the present claims.

Furthermore, Blume does not render obvious the present invention because Blume is non-analogous prior art. To rely on a reference under 35 U.S.C. 103, the reference must be analogous prior art. MPEP 2141.01(a). "In order to rely on a reference as a basis for rejection ... the reference must either be in the field of Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a), quoting *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The Blume reference is directed to an apparatus for mailable documents, specifically the folding and sealing of pre-printed sheets. Applicants' invention is directed to a method of applying adhesive on a web for use in smokers' products. Not only are the industrial applications of the two inventions different, the mechanics of operation are different. For example, the present invention employs a rotor to advance a web, whereas Blume uses a conveyor to move individual sheets of paper. These differences make it impossible for Blume to render the present claims obvious.

Regarding the addition of claims 16 and 17, these new claims are directed to a method

where two different types of adhesive are conveyed to the nozzles. Support for this limitation can be found, for example, in the specification on pages 39-41 and in Figure 5. If the dictionary definition of the word "web" is not believed to be sufficient, dependent claim 18 is added to positively recite that the web is continuous.

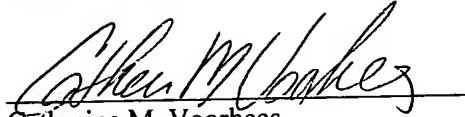
In closing, Applicants wish to present the following additional remarks. The apparatus of Blume applies adhesive on both sides of a sheet of paper, where the present invention applies adhesive on only one side of a webbing. Indeed, a webbing with adhesive on both sides would not work with the present invention. Furthermore, the present invention describes the use of different types of adhesives and their advantages. For example, page 41 of the specification describes using a fire retardant type of adhesive at the end closest to a smoker's mouth, a standard adhesive at another location, and an adhesive with a flavoring agent in a third location. Blume has no such disclosure.

In light of the arguments presented above, it is believed that the pending claims are allowable in light of the prior art. Accordingly, generic claim 1 is allowable and claim 7 should be rejoined and allowed over the prior art of record. Thus Applicants respectfully request that the obviousness rejection be withdrawn, and a Notice of Allowance issued.

Respectfully submitted,

Date: April 25, 2005

CMV:KBL  
DC2/642802

  
Catherine M. Voorhees  
Registration No. 33,074  
Kavita B. Lepping  
Registration No. 54,262  
VENABLE LLP  
P.O. Box 34385  
Washington, D.C. 20043-9998  
Telephone: (202) 344-4000  
Telefax: (202) 344-8300